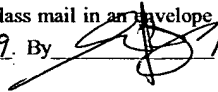




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Printed: Carmen Pili Ekstrom

THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)

Leonel Yanez MARTINEZ et al.)

Serial No. 10/613,433)

Filed: JULY 3, 2003)

Title: **DRY WATER RESISTANT
COAXIAL CABLE AND METHOD
OF MANUFACTURE THEREOF**)

Docket No. MX/JFServ-001)

Mail Stop: Office of Petitions

Group Art Unit: 2831

Examiner: William Mayo II

Commissioner of the United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION TO WITHDRAW FINALITY OF RESTRICTION REQUIREMENT

This petition to withdraw finality of the restriction requirement is filed in response to an Office Action in the above-referenced application mailed May 19, 2009.

REMARKS

Applicants respectfully petition the Office of Petition to withdraw the finality of the restriction requirement imposed by the Examiner in the Office Action mailed May 19, 2009. As discussed in more detail below, Applicants retain their right to submit this petition by having traversed the restriction requirement. The facts underlying this request are as follows:

In an Office Action mailed March 16, 2005, the Examiner imposed a restriction to one of the following inventions is required under 35 U.S.C. §121:

- I. Claims 11-27 (now claims 68-75) drawn to dry resistant coaxial cable;
- II. Claims 28-40 (now claims 76-77), drawn to method of making dry resistant coaxial cable of Claim 11;

Applicants elected, with traverse, Group I, Claims 68-75, drawn to dry, resistant coaxial cable.

In making the above elections, Applicants additionally reserved the right to file divisional applications on any non-elected subject matter after the restriction requirement has been made final. In addition, if any claim in Group I was found allowable, Applicants reserved the right to amend the claims in Group II during prosecution to be of the same scope of any claim found to be allowable in Group I and to request rejoinder of such Group II claims in accordance with MPEP §821.04 and *In re Ochiai*, 37 USPQ 1127.

In the Office Action mailed March 16, 2005, the Examiner acknowledged Applicants' election with traverse of Group I, Claims 68-75, drawn to dry, resistant coaxial cable. The Examiner further acknowledged Applicants' election of Group I, with traverse in the Office Action dated May 19, 2005.

Applicants continue to argue that Group I requires the combination with Group II as discussed in the Applicants' specification. It is submitted that these groups are related as combination/subcombination. The requisite distinctness to support the restriction requirement has not been shown because the combination as claimed requires the particulars of the subcombination. Irrespective of whether the subcombination has utility either by itself or in other different relations, a two way distinctness which was required has not been shown.

Moreover, the Examiner's allegation that the groups are classified separately is not conclusive of the independence of the invention. The classification system is primarily arranged for convenient searching and not necessarily to distinguish separate inventions. Applicants submit that Groups I and II are not distinct as the Examiner has

alleged, but rather represent one single inventive concept warranting examination in a single application. Applicants submit that, in order to consider the invention herein claimed, the subject matter of the indicated Groups I-II should be considered together.

Finally, MPEP§821.04 provides that if Group I, claims 68-75, drawn to coaxial cable were found *allowable*, pursuant to procedures set forth in Official Gazette notice dated March 26, 1996 (1184 O.G. 86), Group II, claims 76-77, drawn to the method of making the coaxial cable which was withdrawn from consideration as a result of restriction requirement should be **rejoined** and the restriction requirement should be withdrawn.

Moreover, the Examiner did not find Applicants' arguments persuasive with respect to the impropriety of the restriction requirement and continued to maintain the restriction requirement. In particular, the Examiner cited MPEP 806.05 (f) and stated that "the test for distinction is (1) the process claimed can be used to make other and materially different product or (2) product as claimed can be made by another materially different process. In this particular case, the second polymer layer may be made by injection molding, spraying or casting rather than extrusion molding." The Examiner did not state whether the process claimed in the present invention define a contribution over the prior art.

Applicants respectfully submit that the Examiner has incorrectly interpreted the requirement of "contribution over the prior art" for a "lack of unity" rejection. The relevant section of 37 CFR. 1.475 states that:

"unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, *considered as a whole*, makes over the prior art (emphasis added)."

The claimed coaxial cable all share a common method of manufacture and share a common utility, or "technical relationship." Applicants note that it is not required by 37 CFR. 1.475 that the "special technical feature" define a contribution over the prior art, but rather that the claimed invention, *considered as a whole*, must define a contribution over

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Serial No. 10/613,833
Petition to withdraw Finality of Restriction Requirement

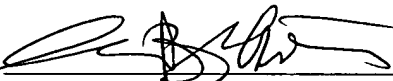
the prior art. Thus, the "special technical feature" of the coaxial cable of the instant invention is not, per se, the cable by itself but also the method of manufacturing the coaxial cable according to claim 68. **The common generic claim, linking claim or subcombination claim with respect to the coaxial cable claims and method of manufacturing claims is that the method of manufacturing claim 75 is dependent on manufacturing of the cable according to claim 68.** Accordingly, Applicants request the withdrawal of the finality of the restriction requirement and examination of the entire scope of the claims as originally presented.

CONCLUSION

In conclusion, Applicants respectfully request the withdrawal of the finality of the restriction requirement/election of species requirement for the reasons set forth above. In the event that there are any problems which can be expedited by telephone conference, the Examiner is invited to telephone the Applicant's undersigned attorney at the telephone number listed below.

Respectfully submitted,
LAW OFFICE OF CARMEN PILI EKSTROM

Attorney Docket No. MX/JFC-Serv-001
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